

REMARKS

Applicants acknowledge receipt of the Office Action dated November 27, 2008, in which the Examiner objected to the Drawings; objected to the Specification; objected to the Claims; rejected claims 1-14 under § 112, second paragraph; rejected claims 1-3, 5, 8, and 12 as anticipated by Bosma (WO 03/008760); rejected claims 4, 13, and 14 as obvious in view of Bosma; and rejected claims 6, 7, and 9-11 as obvious in view of Bosma and Gill (WO 96/22453).

Applicants have amended the claims, drawings and specification and respectfully submit that the case is now in condition for allowance for the reasons set out below.

Objection to the Drawings

A Replacement Drawing Sheet has been submitted, which includes a new Figure 3C. The specification has been amended to reflect the addition of the new figure. Figure 3C illustrates the subject matter of claims 9 and 10 as-filed and therefore does not constitute new matter.

Applicants respectfully submit that, in view of new Figure 3C and the text added on page 6 of the Specification, a further figure illustrating the subject matter of claim 11 is not needed, as one skilled in the art would readily understand said subject matter without further illustration.

Objection to the Specification

The Abstract has been amended to include the word “the” between “than” and “radially outward movement.” Applicants respectfully submit that the definite article is proper, as the radially outward movement of the tubular element corresponds directly to the radial expansion thereof.

The amendments suggested in paragraph 7. of the Office Action have been made.

Objection to the Claims

Lines 3 and 15 of Claim 1 have been amended to improve the language therein, but line 9 has not been amended as Applicant does not understand the Examiner’s intent with respect to that limitation.

Rejection of claims 1-14 under § 112, second paragraph

Claim 1 has been amended to recite that the first and second portions are restrained to the tubular element “such that the distance between the first and second portions changes as a result of radial expansion.”

Applicants have not adopted the language suggested by the Examiner, i.e. that the distance “can change,” because it is a feature of the invention that the distance between the first and second portions does change when the tubular is radially expanded.

Regarding claim 4, Applicant respectfully points out that the welds do not break during expansion and that the first and second portions of the outer structure remain affixed to the tubular during expansion. To answer the Examiner’s question, it is possible for the distance between the first and second portions change as a result of radial expansion of the tubular element because *the tubular element gets shorter* when it undergoes radial expansion. See for example, page 4, lines 19-22, of the specification, which reads, “Referring to FIGS. 1A, 1B there is shown a tubular assembly 1 comprising an expandable tubular element 2 *susceptible to axial shortening upon radial expansion thereof.*” (emphasis added).

It is this shortening of the tubular, in combination with the fact that the first and second portions are affixed to the tubular, that causes the distance between the first and second portions to change (decrease) when the tubular is expanded. As described in the Specification, the outer structure is less susceptible to axial shortening, and therefore bows outward as the tubular expands and gets shorter.

Claim 14 has been amended to correct a grammatical error and to depend from claim 13 so as to provide the missing antecedent basis.

Rejected claims 1-3, 5, 8, and 12 as anticipated by Bosma (WO 03/008760)

Applicant respectfully submits that Bosma does not teach a device meeting the limitations of claim 1.

First, Bosma does not teach an outer structure having first and second portions that are restrained to the tubular element such that the distance between the first and second portions changes as a result of radial expansion of the tubular element. The “outer structure” cited by the

Examiner comprises a centralizer 60 having end parts 64 and 66, and a compression sleeve 17. Compression sleeve 17 is neither “a portion” of centralizer 60, nor is it affixed to the tubular element. In fact, it is critical to operation of the Bosma device that compression sleeve 17 be able to slide along the tubular element, because that is how the centralizer becomes compressed. (See page 9, lines 1-17 and compare Figures 3A and 3B of Bosma).

Applicants expressly dispute the Examiner’s statement, made with respect to claim 8, that “the first portion (64) and the second portion (17) [are] the respective end portions of the outer tubular element.” On the contrary, the drawings illustrate the fact that none of the three components, 64, 60, 17 are connected; the use of the distinct nouns “centralizer” and “sleeve” indicates that separateness of parts 60 and 17; and the text states that the sleeve 17 moves against the centralizer.” All of these aspects rebut the Examiner’s mischaracterization of the Bosma device, inasmuch as individual components cannot properly be characterized as “end portions” of the same component.

Second, there is no evidence that the tubular element of Bosma is susceptible to axial shortening upon radial expansion thereof, as required by claim 1. Expandable tubulars that do not axially shorten upon expansion are known, and there is no teaching in Bosma that would indicate that the tubular therein does shorten. Even if it did shorten, however, it would not function in the manner of the claimed invention, as only one end of centralizer 60 is affixed to the tubular; the other end of centralizer 60 and sleeve 17 are each movable relative to the tubular.

It would not be obvious to affix either the second end of centralizer 60 or sleeve 17 to the tubular, as this would completely eliminate the functionality of the Bosma device.

For these reasons, Applicants respectfully submit that the present claims are patentable over Bosma.

Rejection of claims 4, 13, and 14 as obvious in view of Bosma

Applicant respectfully disputes the Examiner’s statement that “it would have been obvious...to weld the first and second portions of the outer structure to the tubular element [of Bosma].” In fact, if the sleeve 17 of Bosma, which the Examiner has identified as the “second portion,” were welded to the tubular, it would not advance in front of the expansion zone and would instead be radially expanded (or break) without getting axially closer to part 64.

Claims 13 and 14 contain further limitations to claim 1 and are allowable for the reasons set out above with respect to claim 1.

Rejected claims 6, 7, and 9-11 as obvious in view of Bosma and Gill (WO 96/22453).

Because of the shortcomings of Bosma as set out above, the combination of Bosma with Gill does not produce a system meeting the limitations of the claims. Therefore, claims 6, 7, and 9-11, which contain further limitations to claim 1, are allowable for the reasons set out above with respect to claim 1.

Conclusion

Applicants believe they have addressed every issue raised by the Examiner in the Office Action and submit that the case is now in condition for allowance. If it would be considered helpful in resolving any issues in the case, the Examiner is encouraged to contact the undersigned at the number below.

Respectfully submitted,

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